

## CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: January 19, 2005 Name: Steven P. Shurtz Signature: /Steven P. Shurtz/

**BRINKS  
HOFER  
GILSON  
& LIONE**

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appn. of: Fred R. Wolf et al.

Appn. No.: 10/687,025

Filed: Sept. 30, 2003

For: CHEWING GUM CONTAINING  
PHYSIOLOGICAL COOLING AGENTS

Attorney Docket No: 1391-1554 (COLPCT 03)

Examiner: Arthur Corbin

Art Unit: 1761

Mail Stop Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

## TRANSMITTAL

Sir:

## Attached is/are:

Second Supplemental Information Disclosure Statement (3 pgs.), PTO 1449 form (2pgs.), copies of fourteen cited references C35-C48; copies of three court documents: 1) Third Amended Answer and Counterclaim, 2) Defendant Cadbury Adams' Responses To Plaintiff Wm. Wrigley Jr., Company's First Set Of Interrogatories, and 3) case docket dated January 6, 2005.

Return Receipt Postcard

## Fee calculation:

No additional fee is required.

Small Entity.

An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).

A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_).

## Fee payment:

A check in the amount of \$\_\_\_\_\_ is enclosed..

Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.

Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).

The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

January 19, 2005

Date

/Steven P. Shurtz/

Steven P. Shurtz - Reg. No. 31,424

BRINKS HOFER GILSON & LIONE  
NBC Tower - Suite 3600, 455 N. Cityfront Plaza Drive, Chicago, IL 60611-5599

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## SECOND SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with the duty of disclosure under 37 C.F.R. §1.56 and §§1.97-1.98, and more particularly in accordance with 37 C.F.R. §1.97(b)(4), Applicants hereby cite the following references:

## US PATENT DOCUMENTS

DOCUMENT NUMBER Number-Kind Code (If known)	DATE	NAME
2,525,072	10/10/1950	K. K. Kearby et al.
4,020,153	04/26/1977	Rowsell et al.
4,032,661	06/28/1977	Rowsell et al.
4,044,120	08/23/1977	Rowsell et al.
4,059,118	11/22/1977	Watson et al.
4,069,345	01/17/1978	Gascoyne et al.
4,070,496	01/24/1978	Rowsell et al.
4,112,066	09/05/1978	Hussein
4,136,164	01/23/1979	Rowsell et al.
4,137,304	01/30/1979	Rowsell et al.
4,137,305	01/30/1979	Rowsell et al.
4,150,052	04/17/1979	Watson et al.
4,178,459	12/11/1979	Watson et al.
4,193,936	03/18/1980	Watson et al.
4,226,988	10/07/1980	Watson et al.
5,169,658	12/08/1992	Yatka et al.
5,236,719	08/17/1993	Meyers et al.
5,244,760	09/14/1993	Upson et al.
5,458,892	10/17/1995	Yatka et al.
5,543,160	08/06/1996	Song et al.
5,545,416	08/13/1996	Song et al.
5,612,071	03/18/1997	Song et al.

Appn. No. 10/678,025

Attorney Docket No.: 1391/1554

DOCUMENT NUMBER Number-Kind Code (if known)	DATE	NAME
5,614,234	03/25/1997	Song et al.
5,698,181	12/16/1997	Lou
5,800,847	09/01/1998	Song et al.
5,976,581	11/02/1999	Song et al.
6,030,647	02/29/2000	Song et al.
6,080,432	06/27/2000	Tyrrin et al.
6,440,472 B1	08/27/2002	Song et al.
6,455,080 B1	09/24/2002	Wolf et al.
2003/0082271 A1	05/01/2003	Wolf et al.
6,586,023 B1	07/01/2003	Song et al.
6,602,518 B2	08/05/2003	Seielstad et al.
6,613,346 B2	09/02/2003	Seielstad et al.

## FOREIGN PATENT DOCUMENTS

DOCUMENT NUMBER	DATE	COUNTRY
CA 989738	05/25/1976	Canada
GB 1311060	03/21/1973	United Kingdom
GB 2233873 A	01/23/1991	United Kingdom
WO 93/23005	11/25/1993	WIPO
WO 93/25177	12/23/1993	WIPO
WO 94/08550	04/28/1994	WIPO
WO 94/08551	04/28/1994	WIPO
WO 94/21135	09/29/1994	WIPO
WO 94/25003	11/10/1994	WIPO
WO 94/25009	11/10/1994	WIPO
WO 99/13734	03/25/1999	WIPO
WO 99/13870	03/25/1999	WIPO

## OTHER ART REFERENCES

Watson, Hugh R., "Flavor Characteristics of Synthetic Cooling Compounds", *Flavor: Its Chemical, Behavioral, and Commercial Aspects Proceedings of the Arthur D. Little, Inc. Flavor Symposium, 1997*, Published by Westview Press, Boulder CO, 1978, pp 31-50.

Watson, H. R. et al., "New compounds with the menthol cooling effect", *J. Soc. Cosmet. Chem.*, Vol. 29, 1978, pp. 185-200.

Applicants hereby notify the Patent and Trademark Office of pending litigation involving the parent patent for the present case, U.S. Patent No. 6,627,233, brought by the Assignee of the parent patent and the present patent application, Wm. Wrigley Jr. Company, in the U.S. District Court for the Northern District of Illinois, Civil Docket Case

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Appln. No. 10/678,025

Attorney Docket No.: 1391/1554

No. 04-CV-346 titled WM. WRIGLEY, JR. COMPANY vs CADBURY ADAMS USA, and submit herewith a copy of the following documents: 1) Third Amended Answer and Counterclaim, 2) Defendant Cadbury Adams' Responses To Plaintiff Wm. Wrigley Jr., Company's First Set Of Interrogatories, and 3) case docket dated January 6, 2005. These documents are provided for consideration by the Examiner in view of the relationship of the issued patent claims and the pending claims, and the allegation of the invalidity of the '233 patent by the defendant.

For the Examiner's convenience, Applicants are enclosing Form PTO-1449 (two pages), and copies of the above listed non-U.S. patent documents. Since all of the listed references are in English, no further commentary is believed to be necessary for those references, 37 C.F.R §1.98(a)(3). With the exception of four documents (US 2003-0082271 A1, which is also a pending application; U.S. 5,698,181; WO 99/13734; and WO 99/13870), the forgoing documents were produced by the defendant in the above litigation, presumably as prior art to the '233 patent. (It is believed that other references produced by the defendant are already of record in this case.) Applicants respectfully request the Examiner's consideration of the above references and entry thereof into the record of this application. Applicants are providing the above three noted court documents so that the Examiner is apprised of the allegations of invalidity. If the Examiner believes that any of the documents listed in the docket report would be of interest to the Examiner, Applicants will provide copies. Further, if the Examiner wishes to be advised of subsequent papers filed in the litigation, he should so indicate.

No fees are believed to be due with this communication. However, if any filing fees are required relating to this submission, the Commissioner is hereby authorized to deduct said fees from Brinks Hofer Gilson & Lione Deposit Account No. 23-1925.

Respectfully submitted,

January 19, 2005  
Date

/ Steven P. Shurtz/  
Steven P. Shurtz (Reg. No.31,424)

FORM PTO-1449		SERIAL NO. 10/678,025	CASE NO. 1391/1554
LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT		FILING DATE Sept. 30, 2003	GROUP ART UNIT 1761
(use several sheets if necessary)		APPLICANT(S): Fred R. Wolf et al.	

REFERENCE DESIGNATION		U.S. PATENT DOCUMENTS		
EXAMINER INITIAL	DOCUMENT NUMBER <small>Number-Kind Code (if known)</small>	DATE	NAME	CLASS/ SUBCLASS
	C1 2,525,072	10/10/1950	K. K. Kearby et al.	
	C2 4,020,153	04/26/1977	Rowsell et al.	
	C3 4,032,661	06/28/1977	Rowsell et al.	
	C4 4,044,120	08/23/1977	Rowsell et al.	
	C5 4,059,118	11/22/1977	Watson et al.	
	C6 4,069,345	01/17/1978	Gascoyne et al.	
	C7 4,070,496	01/24/1978	Rowsell et al.	
	C8 4,112,066	09/05/1978	Hussein	
	C9 4,136,164	01/23/1979	Rowsell et al.	
	C10 4,137,304	01/30/1979	Rowsell et al.	
	C11 4,137,305	01/30/1979	Rowsell et al.	
	C12 4,150,052	04/17/1979	Watson et al.	
	C13 4,178,459	12/11/1979	Watson et al.	
	C14 4,193,936	03/18/1980	Watson et al.	
	C15 4,226,988	10/07/1980	Watson et al.	
	C16 5,169,658	12/08/1992	Yatka et al.	
	C17 5,236,719	08/17/1993	Meyers et al.	
	C18 5,244,760	09/14/1993	Upson et al.	
	C19 5,458,892	10/17/1995	Yatka et al.	
	C20 5,543,160	08/06/1996	Song et al.	
	C21 5,545,416	08/13/1996	Song et al.	
	C22 5,612,071	03/18/1997	Song et al.	
	C23 5,614,234	03/25/1997	Song et al.	
	C24 5,698,181	12/16/1997	Lou	
	C25 5,800,847	09/01/1998	Song et al.	
	C26 5,976,581	11/02/1999	Song et al.	
	C27 6,030,647	02/29/2000	Song et al.	
	C28 6,080,432	06/27/2000	Tyrpin et al.	
	C29 6,440,472 B1	08/27/2002	Song et al.	
	C30 6,455,080 B1	09/24/2002	Wolf et al.	
	C31 2003/0082271 A1	05/01/2003	Wolf et al.	
	C32 6,586,023 B1	07/01/2003	Song et al.	
	C33 6,602,518 B2	08/05/2003	Seielstad et al.	
	C34 6,613,346 B2	09/02/2003	Seielstad et al.	

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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FORM PTO-1449	SERIAL NO.	CASE NO. 1391/1554
LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT	FILING DATE Sept. 30, 2003	GROUP ART UNIT 1761
(use several sheets if necessary)	APPLICANT(S): Fred R. Wolf	

## FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	COUNTRY	CLASS/ SUBCLASS	TRANSLATION YES NO
C35	CA 989738	05/25/1976	Canada		
C36	GB 1311060	03/21/1973	United Kingdom		
C37	GB 2233873 A	01/23/1991	United Kingdom		
C38	WO 93/23005	11/25/1993	WIPO		
C39	WO 93/25177	12/23/1993	WIPO		
C40	WO 94/08550	04/28/1994	WIPO		
C41	WO 94/08551	04/28/1994	WIPO		
C42	WO 94/21135	09/29/1994	WIPO		
C43	WO 94/25003	11/10/1994	WIPO		
C44	WO 94/25009	11/10/1994	WIPO		
C45	WO 99/13734	03/25/1999	WIPO		
C46	WO 99/13870	03/25/1999	WIPO		

EXAMINER INITIAL	OTHER ART (Including Author, Title, Date, Pertinent Pages, etc.)	
C47	Watson, Hugh R., "Flavor Characteristics of Synthetic Cooling Compounds", <i>Flavor: Its Chemical, Behavioral, and Commercial Aspects Proceedings of the Arthur D. Little, Inc. Flavor Symposium, 1997</i> , Published by Westview Press, Boulder CO, 1978, pp 31-50.	
C48	Watson, H. R. et al., "New compounds with the menthol cooling effect", <i>J. Soc. Cosmet. Chem.</i> , Vol. 29, 1978, pp. 185-200.	

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Rev. Feb.-97

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